

REMARKS

None of the Examiner's references combine a spoke mounted device with an onboard battery powered LED, and further comprising a light absorbing and light emitting housing for the battery and LED. No suggestion exists in the prior art to combine these features. It is far simpler to build the (newly) claimed device than the more complex pattern emitters cited (Yu, Lee). Simplicity is historically a patentable feature. The Federal Circuit has stated that "simplicity does not establish obviousness; indeed, simplicity may represent a significant and unobvious advance over the complexity of prior devices." *Sensonics, Inc. v. Aerosonic Corp.*, 81 F.3d 1566, 1570 (Fed. Cir. 1996).

The ultimate determination of whether an invention would have been obvious under Section 103(a) is a legal conclusion based on underlying findings of fact. *In re Kotzab*, 217 F.3d 1365, 1369 (Fed.Cir. 2000). The underlying factual inquiries include (1) the scope and content of the prior art; (2) the level of ordinary skill in the prior art; and (3) the differences between the claimed invention and the prior art. *Graham v. John Deere Co.* 383 U.S. 1, 17, 86 S.Ct. 684, 15 L.Ed.2d 545 (1966).

If ***all the elements*** (emphasis added) of an invention are found in a combination of prior art references, a proper analysis under § 103 requires, *inter alia*, consideration of two factors:

- (1) whether the prior art would have suggested to those of ordinary skill in the art that they should make the claimed composition or device, or carry out the claimed process; and
- (2) whether the prior art would also have revealed that in so making or carrying out, those of ordinary skill would have a reasonable expectation of success. *In re Vaeck*, 947 F.2d 488, 493 (Fed.Cir. 1991) (citing *In re Dow Chem. Co.*, 837 F.2d 469, 473 (Fed.Cir. 1988).

Both the suggestion and the reasonable expectation of success "must be founded in the prior art, not in the applicant's disclosure." *Velander v. Garner*, 348 F.3d 1359, 1363 (Fed.Cir. 2003). Obviousness, and expectation of success, are evaluated from the perspective of a person having ordinary skill in the art at the time of the invention. While later publications may explain what was known earlier, it would be wrong to impute later-recognized insights-or possible obstacles-to the knowledge available to those skilled in the art at the time of the invention. *Id.* at 1377.

Applicant respectfully disagrees with Examiner's interpretation of the prior art. Peterson's "two sources of light" are first a seat post mounted, external, battery powered source of invisible light, and a second a spoke mounted device having an invisible light absorbing and

visible light emitting flexible planar portion that clearly DOES NOT house a battery and a light emitting diode!

Yu's light slot is NOT a groove to receive a spoke.

Therefore the claimed clip/groove combination to receive a spoke is a new structure not found in the prior art cited.

Helstern's filter is NOT a source of light but rather a tinted screen to control the rendering of color or to distort the light (Encarta® World English Dictionary).

In conclusion, when a new element in the art is combined with known elements, a prime facie case of obviousness is NOT presented. "the combination of elements from non-analogous sources, in a manner that reconstructs the applicant's invention only with the benefit of hindsight, is insufficient to present a prima facie case of obviousness." *In re Oetiker*, 977 F.2d at 1447.

Applicant respectfully requests allowance of all pending claims.

LAW OF OBVIOUSNESS

It is well known that most inventions are composed of elements that *per se* are old and well known. That however, does not make an invention "obvious" under 35 U.S.C. 103. The Examiner's attention is respectfully drawn to, for example, *ACS Hospital Systems, Inc. v. Montefiore Hospital et al.*, 732 F.2d 1572, 1577, 221 USPQ 929 (Fed. Cir. 1984), wherein the Court held that "[o]bviousness cannot be established by combining the teachings of the prior art to produce the claimed combination, absent some teaching or suggestion supporting the combination. Under section 103, teachings of references can be combined *only* if there is some suggestion or incentive to do so."

Also, as stated in *W.L. Gore & Associates, Inc. v. Garlock, Inc.* 721 F.2d 1540, 1553, 220 USPQ 303 (Fed. Cir. 1983):

To imbue one of ordinary skill in the art with knowledge of the invention in suit, when no prior art reference or references of record convey or suggest that knowledge, is to fall victim to the insidious

effect of a hindsight syndrome wherein that which only the inventor taught is used against its teacher.

Finally, even if all the constituents of an invention may be old, if the result would not have been obvious at the time the invention was made to a person having ordinary skill in the art, then the result may be patentable. *Reiner v. I. Leon Co.*, 285 F.2d 501, 503-504, 128 USPQ 25, (2d Cir. 1960).

In order to determine the basis for the rejection, the Examiner must:

- 1). Determine the scope and contents of the prior art;
- 2). Ascertain the differences between the prior art and the claims in issue;
- 3). Resolve the level of ordinary skill in the pertinent art; and
- 4). Evaluate evidence of secondary considerations.

Other basic considerations include:

- 1). The claimed invention must be considered as a whole;
- 2). The references must be considered as a whole and must suggest the desirability and thus the obviousness of making the combination;
- 3). The references must be viewed without the benefit of impermissible hindsight vision afforded by the claimed invention; and
- 4). Reasonable expectation of success is the standard with which obviousness is determined.

Finally, to sustain a *prima facie* case of obviousness:

- 1). There must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings;
- 2). There must be a reasonable expectation of success; and
- 3). The prior art reference must teach or suggest all the claim limitations.

The Examiner fails to meet the requirements to sustain an obviousness rejection based on these references.

LAW OF ANTICIPATION

Section 102 (e) provides:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent....

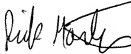
A claim is anticipated only if each and every element as set forth in the claim is found either expressly or inherently described, in a single prior art reference. See: Verdegaal Bros. v. Union Oil Co. of California, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed Cir. 1987), Structural Rubber Prods. CO. v. Park Rubber Co., 749 F.2d 707, 715, 223 USPQ 1264, 1270, (Fed. Cir. 1984), Connell, 722 F.2d at 1548, 220 USPQ at 198; Kalman v. Kimberly-Clark Corp., 713 F.2d 760, 771, 218 USPQ 781, 789 (Fed. Cir. 1983), cert. denied, 465 U.S. 1026, 104 S. Ct. 1284, 79 L. Ed.2d 687 (1984).

Applicant respectfully requests the Examiner to pass this application to allowance.

Date: _____

2/26/07

Respectfully submitted,



Rick Martin
Reg. No. 32,267
Patent Law Offices of Rick Martin, P.C.
416 Coffman Street
Longmont, CO 80501
(303) 651-2177